

Hearing:
December 7, 2004

THIS DECISION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed: 1/28/2005

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Acquisition Solutions, Inc.

Serial No. 76313476

Ralph M. Tener of McCandlish & Lillard for applicant.

Theodore McBride, Trademark Examining Attorney, Law Office
103 (Dan Vavonese, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative
Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge:

An application was filed by Acquisition Solutions, Inc. to register the mark ACQUISITION SOLUTIONS TRAINING INSTITUTE ("ACQUISITION" and "TRAINING INSTITUTE" disclaimed) for "training services, namely, conducting courses, seminars, conferences, workshops, materials, and multi-media presentations, in the fields of government contracting, market research, strategic sourcing and source selection, mission and strategic planning, requirements definition, asset management, supply chain management, program management, contract performance management,

acquisition knowledge management, procurement, and related laws, regulations, policies, and practices.”¹

The trademark examining attorney refused registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the ground that applicant’s mark is merely descriptive of its identified services.

When the refusal to register was made final, applicant appealed. Applicant and the examining attorney filed briefs.² An oral hearing was held before this panel of the Board.

Applicant argues that the term “SOLUTIONS” in its mark is very broad and general, and fails to specifically identify anything listed in the recitation of its training services. Pointing to the meaning of the term “solutions,” applicant asserts that although it sells training services that are in many cases expected to lead to answers or dispositions of problems, applicant does not sell

¹ Application Serial No. 76313476, filed September 17, 2001, based on a date of first use anywhere and a date of first use in commerce of January 22, 2001.

² Applicant has made references to and relied upon prior Board opinions marked, as is the present opinion, “This disposition is not citable as precedent of the TTAB.” Decisions that are so designated are not citable authority and will not be considered by the Board. Applicant should refrain in the future from citation to unpublished Board opinions. See *In re A La Vielle Russie Inc.*, 60 USPQ2d 1895, 1897 n. 2 (TTAB 2001); and *In re Polo International Inc.*, 51 USPQ2d 1061, 1063 n. 3 (TTAB 1999). See generally TBMP §§101.03 and 1203.02(f) (2d ed. rev. 2004).

"solutions," that is, methods, processes, answers or dispositions. Applicant also contends, contrary to the examining attorney's view, that it is not a "solutions provider," and that this term of art describes a specialized type of services in the information technology field different from applicant's services. The fact that the component "SOLUTIONS" in the mark suggests that applicant's training services may solve a customer's problem does not make the term merely descriptive; instead, applicant argues that it uses the term figuratively and suggestively to evoke the intended results of utilizing its training services. Applicant points to the existence of several third-party registrations of "SOLUTIONS"-type marks in the training services field wherein there is no disclaimer of the term. Applicant also points to the issuance of its registration (No. 2692380 on March 4, 2003) of the mark ACQUISITION SOLUTIONS for a variety of printed materials (e.g. newsletters, guides, research reports, updates and training materials) in various fields (government contracting, etc.--these fields are identical as set forth in the registration and this application), noting that the registration issued on the Principal Register with a disclaimer of "ACQUISITION" but no disclaimer of "SOLUTIONS." In support of its position,

applicant submitted a dictionary definition of the term "solutions," and copies of third-party registrations.³

The examining attorney maintains that applicant is in an industry that makes use of the term "solutions" to describe a feature of the type of services offered by applicant. The examining attorney points to applicant's website wherein applicant describes itself as a small business "dedicated to providing experienced, solutions-oriented acquisition support to federal agencies." In addition to this Internet evidence, the examining attorney relied on a dictionary definition of "solutions provider," and on several third-party registrations wherein the term "SOLUTIONS" is disclaimed apart from the mark.

The Examining Attorney bears the burden of showing that a mark is merely descriptive of the relevant services. In re Merrill Lynch, Pierce, Fenner, and Smith Inc., 828 F.2d 1567, 4 USPQ2d 1141, 1143 (Fed. Cir. 1987). A mark is descriptive if it "forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods

³ Applicant introduced, during the prosecution of its application, several third-party registrations. Attached to its reply brief are copies of nineteen additional third-party registrations. Applicant also filed a separate request that the Board consider this additional evidence. At the oral hearing, the examining attorney consented to the entry of this evidence into the appeal record. Accordingly, we have considered all of the third-party registrations submitted by applicant.

[or services]." *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 189 USPQ 759, 765 (2d Cir. 1976) (emphasis added). See also: *In re Abcor Development Corp.*, 616 F.2d 525, 200 USPQ 215 (CCPA 1978). Moreover, in order to be descriptive, the mark must immediately convey information as to the features, qualities or characteristics of the services with a "degree of particularity." *Plus Products v. Medical Modalities Associates, Inc.*, 211 USPQ 1199, 1204-1205 (TTAB 1981). See also: *In re Diet Tabs, Inc.*, 231 USPQ 587, 588 (TTAB 1986); *Holiday Inns, Inc. v. Monolith Enterprises*, 212 USPQ 949, 952 (TTAB 1981); and *In re TMS Corp. of the Americas*, 200 USPQ 57, 59 (TTAB 1978). It is well established that the determination of mere descriptiveness must be made not in the abstract or on the basis of guesswork, but in relation to the services for which registration is sought, the context in which the mark is used, and the impact that it is likely to make on the average purchaser of such services. See *In re Consolidated Cigar Co.*, 35 USPQ2d 1290 (TTAB 1995).

The term "solution" is defined, in relevant part, as follows: "the method or process of solving a problem; the answer to or disposition of a problem." *Merriam-Webster's Dictionary* (4th ed. 2000).

The term "solutions" is a general, broad term in regard to training services. See *In re Hutchinson Technology*, 852 F.2d 552, 7 USPQ2d 1490 (Fed. Cir. 1988). The term does not convey an immediate idea of the specified services; rather, the general nature of the term would require a mental pause and thought that renders the term suggestive rather than merely descriptive of applicant's services.

In turn, the entire mark, ACQUISITION SOLUTIONS TRAINING INSTITUTE, does not immediately impart with any "degree of particularity" and without the exercise of some degree of thought or imagination, information about applicant's training services. Applicant, rather than literally providing acquisition solutions, provides training services which it hopes will lead to solutions to clients' acquisition problems. The mark only suggests the results to be achieved by the recipients of applicant's training services and, thus, the mark is one step removed from being merely descriptive. We also agree with applicant that its services do not fit into the category of information technology services offered by a "solutions provider."

As to the third-party registrations, neither those submitted by the examining attorney which include

disclaimers of the term "solutions," nor those introduced by applicant without disclaimers of the term "solutions," are very helpful in deciding the present case. Although many of the registrations cover training services, it would be stretching to say that all of the registrants are in the same training field (e.g., some of the ones submitted by the examining attorney cover information technology services). In general, it is apparent that the treatment of the term "solutions" by the Office has been mixed. In any event, each case must be decided on its own merits, and neither the Board nor the examining attorney is bound by the prior actions of the Office. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001).

In summary, we find that the term "SOLUTIONS" in applicant's mark is only suggestive when used in connection with applicant's services. This record does not establish that the mark ACQUISITION SOLUTIONS TRAINING INSTITUTE as a whole is merely descriptive of applicant's training services. See *Bose Corp. v. International Jensen Inc.*, 963 F.2d 1517, 22 USPQ2d 1704 (Fed. Cir. 1992); *In re Classic Beverage Inc.*, 6 USPQ2d 1383 (TTAB 1988); and *Manpower, Inc. v. The Driving Force, Inc.*, 212 USPQ 961 (TTAB 1981), *aff'd*, 538 F.Supp. 57, 218 USPQ 613 (EDPA 1982). That is, based on the record before us, it has not been established

that applicant's mark, when used in connection with applicant's services, conveys an immediate idea about the services with any degree of particularity. The significance of the mark and specifically what it describes about the services, when used in connection with the services, is vague enough to render the mark suggestive.

It has long been acknowledged that there is often a very narrow line between terms which are merely descriptive and those which are suggestive, and the borderline between the two is hardly a clear one. See *In re Atavio*, 25 USPQ2d 1361 (TTAB 1992). We concede that the present case is a close one, but find that the mark falls on the suggestive side of the line. In this connection, the Board has noted in the past that if there is doubt about the merely descriptive character of a mark, that doubt is resolved in applicant's favor, permitting publication of the mark so that an interested third party may file an opposition to develop a more comprehensive record. See *In re Atavio Inc.*, supra; and *In re Gourmet Bakers Inc.*, 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register is reversed.